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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/615,279  | 07/08/2003  | Jeff Korn            | 12258-036001              | 8225             |
| 26161   | 7590        | 03/07/2007           |                           |                  |
| FISH & RICHARDSON PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | EXAMINER<br>ROY, BAISAKHI |                  |
|   |             |                      | ART UNIT<br>3737          | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE                              |             |                      | MAIL DATE                 |                  |
| 3 MONTHS  |             |                      | 03/07/2007                |                  |
|   |             |                      | DELIVERY MODE<br>PAPER    |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/615,279

Applicant(s)

KORN, JEFF

Examiner

Baisakhi Roy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/309,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims in '477 directed to an optical coupler system for rotating catheter clearly anticipates the claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,895,137.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the claims in the current application. The patented claims are directed to a system for identifying plaque including a catheter having a collection and delivery fiber, engaged to the distal face of a housing configured to spin about an axis. The system further includes optical relays extending between the central aperture and a central port on the distal face guides the beam from the central aperture to a central port on the distal face. The patented claims include additional structural limitations of the optical coupler system making it more specific than the current application claims.

4. Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 31, and 32 of U.S. Patent No. 6654630. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims anticipate the claims in the current application. The patented claims are directed to a system for identifying plaque including a catheter having a collection and delivery fiber, engaged to the distal face of a housing configured to spin about an axis. The system further includes delivery re-director disposed at the distal end of the collection fiber arrangement for receiving light from the tissue and directing the received light into the collection fiber arrangement. The patented claims include additional structural limitations of the optical coupler system making it more specific than the current application claims.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Boppart et al. (6485413). Boppart et al. disclose an optical coupler comprising a rotating catheter (fig. 8a-8d, col. 31 lines 66 – col. 32 lines 1-32, fig 21a #300) having a collection fiber and a delivery fiber extending therethrough (fig. 8a-d #58, col. 32 lines 15-16, # 316 fig. 20), a housing or cylindrical enclosure or catheter sheath (col. 2 lines 50-61, fig. 8a-d #50, fig. 21a # 308) with a rotatable distal face with multiple ports such as an eccentric port and a central port (col. 14 lines 44-50, fig. 21a, #324, col. 32 lines 33-54), lens (#62) disposed inside the housing to intercept a rotating collection beam emerging from the eccentric port and to re-direct the collection beam to a focus proximal to the lens as the collection beam rotates (fig. 21a #328), and a beam re-director comprising a penta-prism or prism (col. 14 lines 51-52) or a mirror disposed between the lens and the distal face being oriented to direct a delivery beam toward the central port (col. 33 lines 9-19, fig. 21biii # 328). The lens as taught in Boppart et al. could be an offset GRIN lens or other type of lens that is well known in the art such as an axicon

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lens (col. 14 line 26) such that the optical system focuses the beam as a hollow cylinder having a full cone angle (col. 14 lines 35-38). Boppart et al. teach various methods of deflecting a forward-directed beam where one embodiment includes a housing or cylindrical enclosure (fig. 8a-d #50) where the inner cylindrical unit may be rotated while the outer unit may be held stationary (col. 15 lines 41-46). The system includes a light source (fig. 22) disposed to direct a delivery beam radially inward to the beam re-director (claim 8). The system further comprises a detector disposed at the focus for receiving the rotating collection beam and the lens is configured to focus the collection beam off/on an axis of rotation of the distal face (col. 14 lines 21-43, col. 32 lines 33-54).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baisakhi Roy whose telephone number is 571-272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

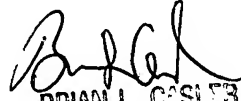
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR

BR

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3737